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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/370,619	08/07/1999	MICHAEL DAVID ERLANGER	114459-05	8285

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EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/370,619

Applicant(s)

ERLANGER, MICHAEL DAVID

Examiner

Ella Colbert

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*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 186-297 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 186-297 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Election/Restriction Requirement***

1. Claims 186-297 are pending. Applicant's election with traverse of Group I, claims 186, 287-297; Group II, claims 187-239 and 252-263; Group III, claims 241-251; and Group IV, claims 264-286 in the reply filed on 08/09/04 is acknowledged. Group I, claims 186, 287-297 was elected with traverse. The Traversal is on the ground(s) that (1) the correspondence between claims 39-157 and the claims now pending is explained at page 24 of the Amendment of April 12, 2004 and because the "application ... has received one or more actions by some other examiner," who determined that the claims were properly examined together, restriction among claims 186-197 is not now warranted; (2) If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions; (3) the restriction admits that all groups are "related" therefore, there is no "serious search burden," and no restriction is proper; (4) the restriction requirement of July 2004 proposes to classify Group I in class 705, subclass 308 and the Patent Office's website indicates there is no such class and subclass and Applicant suggests that Group I should be searched in class 705, subclass 35, or subclass 1; (5) the restriction requirement of July 2004 proposes to classify Group II in class 707, subclass 37 and the Patent Office's web site indicates there is no such class and subclass. Claim 225 recites no limitations relating to "organizing and inter-relating data or files," or any other technology generally associated with implementation of databases but is directed to business use of databases, for

example business data processing. Applicant suggests that Group II should be searched in class 705, subclass 35 ("Finance (e.g., Banking, Investment or Credit)") or subclass 1 ("Automated Electrical Financial or Business Practice or Management Arrangement"); (6) Group III (claims 241-251) should be searched in 705/35. The restriction requirement is incorrect because it proposes to classify Group III in class 707, subclass 10 and as noted above in connection with Group II, the subject matter of Group III does not fall within class 707. Applicant suggests that classification of Group III into class 705, subclass 35 is correct. Subclass 1, though less specific, would be correct; and the Restriction Requirement of January 2003 proposes to classify Group IV in class 705, subclass 1. This is fairly accurate; however, subclass 35 is more specific and is more correct. Applicant suggests that the search burden is unlikely to be "serious" when a search of claim 186 (the independent claim of Group I) will nearly inevitably result in a search of the other groups. For example, claim 264 (Group IV) appears nearly word-for-word within claim 186 (Group I).

***Response to Arguments and Reason for Traversal Above***

2. Response to Issue no. 1: An Examiner can give a restriction any time the Examiner determines there is more than one invention present in the application. When another Examiner inherits an application from another Examiner the Examiner treats the application as a new application to be examined and makes a determination.

Response to Issue no. 2: the search in different classes and subclasses does pose a burden on the examiner when the search is in a different class and subclass than the Examiner's classes and subclasses. Each section in Business Methods is

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broken down into different classes and subclasses. For example, class 705, subclass 1 is Business processing which is not the class and subclass that this Examiner examines. Also, a restriction can be given when claims are in the same class and subclass if they contain divergent subject matter. For Example: Claim 186 has elements A-J and claim 287 has element f of claim 186, and claim 294 also has element f of claim 186; Claim 187 has none of the same elements as claim 186; Claim 213 has element B of claim 187, claim 225 has element A, and claim 252 has most of the elements of claim 187 and so on and so forth. Therefore, this is an example of the claims and the reason they are classed together. Each independent claim is analyzed in the manner above to determine whether a restriction is proper. Claim 186 and claim 264 contain different subject matter. Claim 186 reads "during an application process for loans or lines of credit offered by a plurality of offerers ..." and claim 264 reads "during an application process for financial products offered by a plurality of offerors, obtaining information describing solicitations made by a plurality of applicants for financial products ...". Claim 186 references a market for loans or lines of credit offered to consumers ..." and claim 264 references "during an application process for loans or lines of credit offered by a plurality of offerers ..." this is different.

Response to Issue no. 3: this argument was addressed above in Issue no. 2.

Response to Issue no. 4: Group I was classed in class 705, subclass 308 in error. The proper class is 705, subclass 38 ((Credit (risk) processing or loan processing (e.g., mortgage). The Examiner disagrees that Group I should be classed in 705, subclass 35 or subclass 1.

Response to Issue no. 5: Group II was classed in class 707, subclass 37 in error. The proper class is 705, subclass 37.

Response to Issue no. 6: Group III, claims 241-251 are directed to data processing functions for transactions of financial products. Data processing functions for transactions of financial products is classed in class 705, subclass 35. Class 707, subclass 10 was in error. Group IV, claims 264-286 is classed in class 705, subclass 1 which is accurate.

The previous Election/Restriction is hereby withdrawn in view of Applicant's arguments and a new Election/Restriction is given with corrections as stated here below.

***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 186 and 287-297, drawn to loans or lines of credit and underwriting, classified in class 705, subclass 38.
  - II. Claims 187-239 and 252-263, drawn to trading using an intermediary, classified in class 705, subclass 37.
  - III. Claims 241-251, drawn to data processing functions of financial products, classified in class 705, subclass 35.
  - IV. Claims 264-286, drawn to obtaining information for qualifying a loan applicant, classified in class 705, subclass 1
5. Inventions Group I, Group II, Group III, and Group IV are related as subcombinations disclosed as usable together in a single combination. The

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subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as offering loans or lines of credit to consumers and underwriting standards. Invention Group II has separate utility such as trading using an intermediary. Invention Group III has separate utility such as providing access to information. Invention Group IV has separate utility such as obtaining information for qualifying a loan applicant. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III, and IV. The search required for Group II is not required for Groups I, III, and IV. The search for Group III is not required for Groups I, II, and IV. The search required for Group IV is not required for Groups I, II, and III. It is for these reasons restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

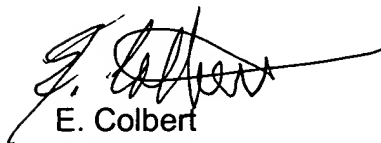
9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Inquiries***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert  
November 9, 2004